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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,490	09/08/2003	E. Scott Hagermoser	59004US002	2018
33692 7590 08/28/2009 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427				
EXAMINER MOON, SEOKYUN				
ART UNIT 2629		PAPER NUMBER		
NOTIFICATION DATE 08/28/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte:* E. SCOTT HAGERMOSE and MICHAEL J. ROBRECHT

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Application No. 10/658,490  
Technology Center 2600

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Mailed: August 28, 2009

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Before DEBORAH L. PERRY, *Supervisory Paralegal Specialist, Review Team.*

**ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER**

This application was electronically received by the Board of Patent Appeals and Interferences on June 20, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

EXAMINER'S ANSWER, GROUNDS OF REJECTION

A review of the file finds that the grounds of rejection of the claims as provided in the Examiner's Answer mailed March 9, 2009 under the heading "Grounds of Rejection" is not consistent with the grounds of rejection of claims set forth in the last Office action of record. The grounds of rejection of the claims as provided in the Examiner's Answer must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Each Grounds of rejection to be reviewed on appeal must be identified and any new grounds of rejection must be provided under a separate heading "New Grounds of Rejection" in the Examiner's Answer and must include the approval of the TC Director or his/her designee. *See also Manual of Patent Examining Procedure (MPEP) § 1207.02 and 1207.03 (8<sup>th</sup> ed. Rev. 6, Sept 2007) for details.*

Specifically, the following rejections were presented in the Final Rejection mailed September 24, 2008:

- Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gillespie, Pryor, Neuman as applied to claims 1-7, 9-11, 13-16, 28-38, and 42 above, and further in view of Nagasaka (US 2004/0195031).
- Claims 24, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gillespie and Pryor as applied to Claims 23 and 27 above, and further in view of Reighard (US 5,423,569),

- Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gillespie, Pryor, Neuman and further in view of Pepper (US 4, 755, 634).
- Claims 11 and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gillespie, Pryor, Neuman and further in view of Redmayne (US 5,650,597).

A review of the Examiner's Answer finds that it is unclear what the status of the above previously rejected claims are, because they were omitted from the Examiner's Answer.

Clarification of the record is required for all Grounds of Rejection to be reviewed on appeal, specifically the above omitted rejections.

### Conclusion

Accordingly,

it is ORDERED that the application is returned to the Examiner to;

- 1) vacate the Examiner's Answer mailed March 9, 2009;
- 2) to issue a new Examiner's Answer setting forth the correct Grounds of Rejection and to correct other sections of the Answer as may be required;
- 3) and to include the approval of the TC Director or his/her designee (as required for any new grounds of rejection);

Application No. 10/658,490

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

DLP/dw

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